

**REMARKS**

Applicant thanks the Examiner for a thorough examination of the present application, but respectfully requests reconsideration of the present application in view of the reasons that follow. Claims 1-20 are currently pending in this application.

In the final Office Action dated May 30, 2008, the Examiner rejected claims 1 and 3-20 based on the combination of Spurr et al. in combination with Patton. In response to this rejection Applicant filed an RCE with claim amendments and arguments on July 29, 2008. In this amendment, Applicant argued in detail why neither Spurr et al. nor Patton teaches or even suggests the features recited in the claims. In response to these arguments, the Examiner withdrew the Patton reference in the outstanding Office Action of August 28, 2008. However, surprisingly, in the outstanding Office Action, the Examiner still relies on the Spurr reference. In particular, the Examiner rejected claims 1, 3-8, and 10-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,674,923 to Shih et al. (Shih) in view of U.S. 6,381,418 to Spurr et al. (Spurr). Applicant disagrees with this rejection and traverses for at least the reasons set forth below.

Independent claim 1 recites “a plurality of memory tags coupled to the substrate; wherein each memory tag has storage capacity to store a high resolution copy of an image.” (Emphasis added). Independent claims 12, 17, and 18 recite similar features. Applicant respectfully submits that neither Shih nor Spurr teaches or even suggests a memory tag with the storage capacity to store a high resolution copy of an image.

Shih generally teaches a method and system for providing a photograph with a label, wherein the label includes a web album URL and password information. (*See, e.g.*, Figures 1-13; col. 1, lines 55-58; col. 3, lines 34-41; Abstract). More particularly, Shih describes that “location information is provided on the print which identifies the electronic location at which a digital record of the image that can be accessed electronically.” (Col. 1, lines 55-58). As such, a label with a URL of the web album is always located on the picture. With regard to memory tags, the

only mention in Shih related to memory tags is the discussion at col. 5, line 58 - col. 6, line 8, which states that a “radio frequency (RF) chip” may be provided on a hard copy of the print. This RFID chip is used to store “a predetermined amount of money to be charged and, as money is spent, this account balance is adjusted to reflect individual transactions.” Thus, the RFID of Shih is used in a manner similar to that of a gift card, where an account balance is stored and subtracted based on use. For example, Shih explains that a denomination may be stored for indicating an amount of money available for use in obtaining goods and/or services relating to the image. (*See, e.g.*, col. 5, lines 22-43). Accordingly, the RFID of Shih is merely used to store a denomination or account balance amount.

In contrast, the independent claims require a memory tag with the storage capacity to store a high resolution copy of an image. The RFID of Shih clearly does not meet this requirement. First, the RFID of Shih is not configured to store an *image*. Second, the RFID of Shih is not configured to store a *high resolution* copy of an image. As discussed throughout the application, the memory tag of the present application has a “much larger memory than a conventional RFID.” (*See*, page 5, line 1 of present application). This larger memory is required to store high resolution images. In contrast the RFID of Shih is a basic RFID configured to store a monetary balance. This simple RFID of Shih cannot be considered the same as a memory tag configured to store high resolution images. Accordingly, Shih fails to teach at least this feature expressly required by each independent claim.

Additionally, Applicant submits that it would not have been obvious to combine another art with Shih in an attempt to cure this deficiency. This is because one of ordinary skill in the art at the time of the invention would not have been motivated to modify the teachings of Shih to include a memory tag suitable for storing high resolution images. Doing so would defeat the entire purpose of the Shih reference. For instance, Shih is directing to providing a URL “for identifying the remote location where the high resolution digital images are stored.” (Col. 3, lines 40-41). Thus, the object of Shih is to provide an indicator (*i.e.*, the URL) which provides the location of the high resolution digital images stored in a remote database. If Shih were

modified to include memory tags with high resolution images stored thereon, there would be no reason to provide indicators or labels to identify where the high resolution images are stored (since they would obviously be stored on the print). Thus, if Shih were modified to include Applicant's claim element, the result of the modification would render Shih unsatisfactory for its intended purpose. As discussed in section 2413.01(v) of the MPEP, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed combination." Accordingly, Applicant submits that any potential modification to Shih in an attempt to read on the above-discussed claim element would lack motivation and would therefore be improper.

With regard to the Examiner's reliance on the Spurr reference, even if the references were combinable (which they are not for the reasons discussed above), Applicant submits that Spurr does not cure the deficiencies associated with Shih, since Spurr also fails to teach or suggest a memory tag with the storage capacity to store a high resolution copy of an image. Spurr is directed to a single print which has a memory associated with the single print. (*See, e.g.*, Abstract; Figure 1; col. 1, lines 6-9; and col. 3, lines 22-62). In particular, Spurr teaches that the single print 30 includes a transponder 22 with an associated memory 24. (*See, e.g.*, Figure 1 and col. 4, lines 62-67). The memory of Spurr is configured to store detailed information about the single printed image. (*See, e.g.*, Abstract; col. 3, lines 28-44, and col. 7, lines 20-50). Such data can be beneficial for an automatic identification procedure. For example, Spurr teaches that "the present invention allows the operator to quickly scan a box containing a plurality of prints and to quickly identify and independently access information concerning each print in the box, without handling the prints individually." (Col. 3, lines 58-63). Furthermore, such data may be beneficial for determining specific conditions under which the print was processed. (*See, e.g.*, col. 3, lines 29-31). For example, Table 1 of Spurr states that the type of data stored, with regard to a single printed image, may include: proofing system identifier filename, date/time stamp, dot gain, density settings, dot shape, screen ruling, screen angle, paper type, and thermal donor batch settings.

Spurr, however, fails to teach or suggest a memory tag which has a “storage capacity to store a high resolution image,” as recited in independent claims 1, 12, 17, and 18. Applicant notes that the Examiner cited col. 9, lines 14-22 as corresponding to this claim element.

Applicant respectfully disagrees. This portion of text states:

Within the scope of the present invention are any number of possible arrangements of memory contents, as indicated in the exemplary description for Tables 1 and 2 hereinabove. Any one of known digital data encoding methods could be used to compress stored data in memory. Where it is advantageous to store more information than can be contained on a single transponder, multiple transponders could be affixed to the substrate.

Thus, the above-cited portion of Spurr merely indicates that the various information described in Tables 1 and 2 may be *arranged* or *compressed* in various manners. However, there is no discussion or even a hint that the information may be an *image*. Moreover, there is simply no discussion of a *high resolution* image being stored thereon. Still further, there is no discussion of a memory suitable for the amount of data associated with a high resolution image. If anything, Spurr implies that a large amount of data would require “multiple transponders.” Thus, Spurr clearly did not intend for a single transponder to store the large amount of data associated with a high resolution image. Accordingly, Spurr fails to cure the deficiencies associated with Shih.

Furthermore, and as discussed in Applicant’s previous response, it would not have been obvious to modify Spurr to add more memory in an attempt to read on the present claims. This is because adding more memory to the RFID of Spurr would increase the real estate/footprint of the RFID and therefore make the device unsuitable for an index print. In addition, adding more memory would change the overall architecture of the RFID. Still further, the RFID discussed in Spurr is low frequency (*e.g.*, 13. 56 Mhz). In such a low frequency RFID, the voltage induced is proportional to the frequency. Therefore, a particular amount of antenna coil turns are needed to produce enough voltage for operation. (*e.g.*, as many as 100-150 turns per layer in 3 layers). Such an RFID arrangement contrasts the arrangement of the present application. Finally, Applicant notes that the RFID of Spurr has a low power transfer and therefore a low data rate.

Therefore, if the memory were somehow increased to store a high resolution image, it would take an extremely long time to read and/or write data. Accordingly, if the RFID of Spurr was modified to include the storage capacity to store a high resolution image, the resulting device would be unworkable because the read/write times would be too long for its intended purpose. As such, Applicant submits that it would not have been obvious to one of ordinary skill in the art to modify Spurr to include enough memory to store high resolution images. For at least the above reasons, Applicant submits that Shih and Spurr, whether considered alone or in combination, do not teach or suggest a memory tag with the storage capacity to store a high resolution copy of an image.

Furthermore, independent claim 1 also recites that “the memory tag associated with at least one of the plurality of index images is configured to store a high resolution copy of the index image it is associated with.” Independent claims 12, 17, and 18 recite similar features. As discussed in detail above, neither Shih nor Spurr teaches the prong of this claim related to high resolution. However, in addition to this deficiency, Applicant respectfully submits that neither Shih nor Spurr teaches or suggests *a memory tag associated with a index image* and configured to store a high resolution image *of that index image*. In other words, neither reference describes an arrangement where a memory tag stores an image related to a particular index image.

As discussed in detail above, Shih merely teaches a RFID which stores a denomination or account balance amount – similar to that of a gift card. (*See, e.g.*, Col. 5, lines 22-43). Shih, however, does not teach or even mention anything related to storing an image. Moreover, Shih does not discuss that the RFID is associated with a particular index image. As such, Shih is also deficient with respect to this claim element.

Spurr does not cure this deficiency associated with Shih, as Spurr also fails to describe an arrangement where a memory tag stores an image related to a particular index image. Instead, Spurr merely teaches that the memory associated with the transponder is configured to store detailed *information* about the single printed image. (*See, e.g.*, Abstract; col. 3, lines 28-44, and col. 7, lines 20-50). For example, Table 1 of Spurr states that type of data stored, with regard to a

single printed image, may include: proofing system identifier filename, date/time stamp, dot gain, density settings, dot shape, screen ruling, screen angle, paper type, and thermal donor batch settings. However, there is no discussion whatsoever related to storing an *image*, much less an image related to an *index* image. As such, Spurr fails to cure the deficiencies associated with Shih with regard to this claim element.

Additionally, independent claim 1 also recites that “one of the plurality of memory tags is configured to store at least one of a list of index images, respective locations of the index images, and locations of the memory tags associated with at least one of the plurality of index images.” Independent claims 12, 17, and 18 recite similar claim elements. Applicant respectfully submits that neither Shih nor Spurr teaches or suggests this claim element.

In rejecting this claim element, the Examiner asserted that Shih disclosed this feature at column 8, lines 45-57. Applicant respectfully disagrees with this assertion. At column 8, lines 45-57, Shih states (emphasis added):

In the case of a card having an RF chip 56 as shown in FIGS. 12 & 13, the card need only be brought in the range of the reading device 105. Thus, a customer bringing up a hard copy print 10, such as shown in FIGS. 6-13 can swipe it through the reading device 105 (or pass it within range of a second reading device 107 if an RF chip is used). The kiosk 100 will recognize the code and automatically perform the appropriate communication link to where the images are stored thereby allowing immediate access to the image storage site without any further entry or other work on the part of the party using the kiosk.

Accordingly, this cited portion of Shih merely indicates that a kiosk can be used to read information (*e.g.*, URL) off of a hard copy of an image and thereby access a storage site (*e.g.*, data server or web album) comprising the images. There is no discussion or even a suggestion that the information read from the hard copy of an image is a list of index images, respective locations of the index images, or locations of the memory tags associated with at least one of the

plurality of index images. Accordingly, Applicant submits that Shih fails to teach or suggest this claim element expressly required by each independent claim.

Furthermore, Spurr does not cure this deficiency because Spurr also fails to teach a memory tag used to store a list of index images, respective locations of the index images, or locations of the memory tags associated with at least one of the plurality of index images. Instead, and as discussed above, Spurr merely teaches storing information related to the print such as proofing system identifier filename, date/time stamp, dot gain, density settings, dot shape, screen ruling, screen angle, paper type, and thermal donor batch settings. Since none of these correspond to the claim requirement, Applicant submits that Spurr also fails to teach or suggest this claim element.

For at least the reasons discussed above, Applicant submits that the Examiner's combination of Shih and Spurr is deficient with respect to a plurality of elements recited in the claims. Moreover, even if all the claim elements were recited (which they are not), Applicant submits that the combination of the two references would not have been obvious to one of ordinary skill in the art at the time of the invention.

Because none of the references cited by the Examiner, either separately or in combination with each other, teaches or suggests all of the features recited in independent claims 1, 12, 17, and 18, Applicant submits that independent claims 1, 12, 17, and 18 are patentable over these cited references. Furthermore, because dependent claims 2-11, 13-16, 19, and 20 are each directly or indirectly dependent upon independent claims 1, 12, 17, and 18, Applicant submits that each of these claims are allowable for at least the same reasons discussed above, in addition to their own reasons which Applicant reserves the right to argue at a later time if necessary.

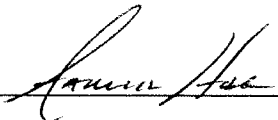
Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 80-2025. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 80-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 80-2025.

Respectfully submitted,

Date 11/13/08

FOLEY & LARDNER LLP  
Customer Number: 22879  
Facsimile: (202) 672-5399

By 

William T. Ellis  
Attorney for Applicant  
Registration No. 26,874

M. Aamir Haq  
Agent for Applicant  
Registration No. 61, 092  
Telephone: (202) 672-5394